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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/603,541	06/25/2003	Jesper B. Lind	MS 180583.01	4073
22801	7590	06/10/2009		
LEE & HAYES, PLLC 601 W. RIVERSIDE AVENUE SUITE 1400 SPOKANE, WA 99201			EXAMINER ROBERTSON, DAVID	
			ART UNIT	PAPER NUMBER
			2121	
			MAIL DATE	DELIVERY MODE
			06/10/2009	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

## Application No.

10/603,541

## Applicant(s)

LIND ET AL

## Examiner

Dave Robertson

## Art Unit

2121

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 20 January 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-157 is/are pending in the application.
- 4a) Of the above claim(s) 5-100 and 102-149 is/are withdrawn from consideration.
- 5) ☐ Claim(s) 1-4, 150, 151 and 157 is/are allowed.
- 6) ☒ Claim(s) 101 and 152-156 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

#### **DETAILED ACTION**

1. This is a Final office action in response to Applicant's reply of 1/20/2009. Claims 1-157 are pending. Claims 1-4, 101, and 150-157 are examined herein, claims 5-100 and 102-149 having been withdrawn from further consideration as being drawn to a non-elected invention.

#### ***Response to Amendment***

2. Applicant amends claim 101 in response to rejection under 35 U.S.C. 101. However, merely reciting that *at least one instruction is executed on a processor* does not create a sufficient tie to a particular apparatus. Insignificant extra-solution activity such as data gathering, data output, transmitting or display, does not transform an unpatentable process into a patentable process. Claim 101 recites a step of mere data gathering: *receiving an item set...*, which, as the *at least one step executed on a processor*, the tie to the particular apparatus relates only to an insignificant step. Accordingly, the rejection is maintained.

#### ***Response to Arguments***

3. Applicant's arguments filed 1/20/2009 are persuasive with respect to Linden et al. (US 6,216,649) in view of Karypis et al. ("Evaluation of Item- based Top-N Recommendation Algorithms" 2001).

**Claim Rejections - 35 USC § 101**

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. Claims 101 and 152-156 are rejected under 35 U.S.C. 101 based on Supreme Court precedent, and recent Federal Circuit decisions.

For a process to be patentable subject matter under § 101 the process must (1) be tied to another statutory class of invention (such as a particular apparatus) or (2) transform subject matter to a different state or thing. See *Diamond v. Diehr*, 450 US 175, 184 (1981); *Parker v Flook*, 437 US 584, 588 n9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 US 780, 787-88 (1876). If neither of these requirements is met by the claim, the method is not a patent eligible process. To qualify under § 101 as a statutory process, the claim should positively recite the other statutory class (the thing or product) to which it is tied, for example by identifying the apparatus that accomplishes the method steps, or positively recite the subject matter that is being transformed, for example by identifying the material that is being changed to a different state.

In the present case, none of the method (process) claims recite a step transforming subject matter to another state or thing or tied to another statutory class, such as a particular apparatus. Insignificant extra-solution activity such as data gathering, data output, transmitting or display, does not transform an unpatentable process into a patentable process. For example, in claims 101, merely reciting that *at least one instruction is executed on a processor* does not invoke a sufficient tie to a particular apparatus. Claim 101 recites a step of data gathering *receiving an item set...*, which, if this is one step *executed on a processor*, relates only to an insignificant step of the claimed process. Lacking such a sufficient tie, the claimed methods are ineligible for patenting under 35 USC 101.

Appropriate amendment is requested.

***Allowable Subject Matter***

6. Claims 1-4, 150, 151, and 157 are allowed. Claims are allowable over the prior art for reasons given and supported by Applicant's arguments filed 1/20/2009.

Because of the large number (~150) of claims withdrawn, Applicant is invited to review claims previously withdrawn but now potentially allowable if made dependent on an allowed claim. (Examiner notes that the withdrawn claims have not previously been fully examined, however, the dependent claims are directed to a multitude of specific embodiments of the invention recited in the independent claims 1, 101, and 157.)

Applicant is therefore invited to contact the Examiner to conduct an Interview to resolve the outstanding rejection and to present final claims for review and allowance.

7. All claims indicated allowable are subject to final search and consideration as finally presented.

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dave Robertson whose telephone number is (571)272-8220. The examiner can normally be reached on 8 am to 6 pm, M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Albert Decady can be reached on (571) 272-3819. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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